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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,751	04/13/2001	Sergey A. Velichko	303.750US1	4280
21186	7590	10/27/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			BARBEE, MANUEL L	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/834,751	Applicant(s) VELICHKO ET AL.	
	Examiner Manuel L. Barbee	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-43 is/are allowed.
- 6) ☒ Claim(s) 1-28 and 44-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/11/06</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|---|---|

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-28 and 44-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-28 are directed to systems comprising modules such as a control module, a state oscillator module, a parametric test equipment module and a test instrumentation module. The modules may be implemented as software (Specification page 4, lines 10-15). Since the modules are claimed without the computer readable medium necessary to realize the functionality, they are considered non-statutory functional descriptive material (See MPEP 2106). Claims 44-58 are directed to a machine-readable medium with instructions stored for controlling using the control module and other modules. The machine-readable medium is not necessarily a computer readable medium and therefore claims 44-58 are also considered non-statutory functional descriptive material.

Allowable Subject Matter

3. Claims 29-43 are allowed.
4. The following is a statement of reasons for the indication of allowable subject matter: Ekstedt et al. and Chen et al. do not teach a method of controlling a semiconductor parametric test system that includes controlling via a control module concurrent operation of semiconductor test equipment and operation of parametric test instrumentation. Further, claim 29 is directed to a process that uses a control module.

Although the control module may be computer software, as shown above, it is part of a statutory process with an useful, concrete and tangible result of controlling semiconductor test equipment and parametric instrumentation.

Response to Arguments

5. Applicant's arguments filed 11 September 2006 have been fully considered but they are not persuasive. Applicant states that the combination of modules such as the control module in a semiconductor test system with operation of semiconductor test equipment and parametric test instrumentation equipment qualify the pending claims as statutory under 35 U.S.C. §101. Claims 1-28 have limitations for modules that are comprised in a semiconductor parametric test system. However, this does not necessarily comprise the hardware. A system may comprise only a computer program.

Applicant states that states that the control of semiconductor test equipment, and operation of parametric test instrumentation qualifies the claim as statutory under the safe harbor rules in MPEP 2106 IV, B, 2, b, I). However, data transformation does not automatically make a claim statutory (See US Patent and Trademark Office OG Notices 22 November 2005). Applicant states that MPEP 2106 suggests repeatedly that embodiment in a physical medium of any type qualifies machine-readable instructions as statutory subject matter under 35 U.S.C. §101. Functional descriptive material such as computer programs must be embodied in some type of computer-readable medium to be statutory (See US Patent and Trademark Office OG Notices 22 November 2005, Annex IV). Claims 44-58 claim a machine-readable medium with instructions. These instructions may be software, but the machine-readable medium is not necessarily a

computer-readable medium. The machine-readable medium may contain a computer program listing that is not readable by a computer. Therefore, claims 44-58 are non-statutory.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel L. Barbee whose telephone number is 571-272-2212. The examiner can normally be reached on Monday-Friday from 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Manuel L. Barbee
Examiner
Art Unit 2857

mlb
October 24, 2006